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IN THE

Supreme Court of the United States

October Term, 1970

No. 1632

HUGHES TOOL COMPANY,

Petitioner,

v.

INGERSOLL-RAND COMPANY,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Petitioner has requested this Court to grant a writ of certiorari to review the judgment of the court below which held that anticipation or lack of novelty, under 35 U.S.C. 102, is established "if all of the elements of the patent, *or their equivalents* are found in a single prior art structure * * *" (A 25).[1] The Petitioner is asking this Court to decide between "tweedledee and tweedledum"; i.e., should the definition of anticipation include "equivalents" or not.

1. Reference is to the appendix to the Petition; underscoring in quotes is ours unless otherwise specified.

Statement[1]

The Fifth Circuit held that the patent upon which Petitioner (Hughes Tool Company) had brought this action was invalid on the ground of anticipation, 35 U.S.C. 102 (A 28).

In holding the patent invalid the Court affirmed the District Court in finding the patent anticipated under 35 U.S.C. 102; the District Court also found the patent invalid for "obviousness" under 35 U.S.C. 102 (A 22).

In the Petition, Petitioner seeks review of the judgment which adopted the Sixth Circuit's definition of "anticipation" under 35 U.S.C. 102 as including in a single prior art reference all of the claimed elements or their equivalents. Petitioner requests this Court to decide as a matter of law, that the definition of anticipation should exclude "equivalents".

We submit, the Petition is bottomed on trivia and should be denied.

Reasons for Opposition

There is no dispute that all Circuits interpret the technical defense of anticipation, 35 U.S.C. 102 as requiring a

1. Respondent does not accept Petitioner's statements and characterization of the record, but since the merits of the Petition are not affected, Respondent does not burden this Brief in Opposition by a detailed statement, except to state that contrary to Petitioner's "Statement", Respondent did argue the issue of infringement of claim 3 on appeal. Respondent also argued on appeal the issue of prior inventorship.

showing of the claimed elements in a single prior art reference. The question that Petitioner alleges is unsettled is whether the prior art reference must show the *identical* element as claimed, or may it show an *equivalent* of the claimed element. For example, if the claim recites elements A, B and C, is a prior art reference an "anticipation" if it discloses A, B and C^1 where C^1 and C are equivalents? That is the question raised by Petitioner in its Petition.

Petitioner suggests that three Circuits, 6th, 9th and 10th do not permit equivalents within the definition, whereas the 5th Circuit has broken ranks. If that were true, the 5th Circuit should be credited for enlightened judgment, but the vision of the other circuits is not so myopic as suggested by the Petitioner. The quote appearing in the decision by the court below (A 25) reading,

> "* * * novelty is lacking if all the elements of the patent, or their equivalents are found in a single prior art structure where they do substantially the same work in the same way." is from the Sixth Circuit decision *A. J. Industries, Inc.* v. *Dayton Steel Foundry Co.*, 394 F.2d 357, 359 (6 Cir. 1968).

To suggest that any circuit, when presented with the question, would hold otherwise is beyond comprehension. The 5th and 6th Circuits have simply been presented with situations which involved considerations of equivalencies; other circuits have not. In most circumstances, the defendant would simply rely on 35 U.S.C. 103, and the question would not arise.

There is no reason in logic or law to limit the definition of anticipation to a precise and identical disclosure in the

prior art, and accordingly it is respectfully submitted that the Petition for Certiorari be denied.

Respectfully submitted,

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